

Application No. 09/766,726

REMARKS**Summary Of The Restriction Requirement**

Claims 1-4 and 11-26 were subject to a Restriction Requirement imposed by the Examiner on August 25, 2005. Claims 1, 12, and 20 are the independent claims.

In the Restriction Requirement, the Examiner grouped the claims as follows:

Groups	Relevant Claims
Group I	1-4 and 11
Group II	12-19
Group III	20-26

Request for Reconsideration of the Restriction Requirement

In the Restriction Requirement of August 25, 2005, the Examiner states that three distinct inventions are present in the application, that the inventions have acquired a separate status in the art, and that the search required for any one invention is not required for the other inventions. Based on that analysis, the Examiner concluded that the inventions are restrictable. Applicant traverses the Restriction Requirement asserted by the Examiner in the present application.

Applicant submits that the Examiner failed to establish two-way distinctness between the groups and reasons for insisting on the restriction, as set forth in more detail below

The Examiner's Burden to Support a Restriction Requirement of an Alleged Combination/Subcombination

To support a Restriction Requirement, the Examiner must show both (1) two-way distinctness and (2) reasons for insisting on restriction, i.e., separate classification, status, or field of search. See MPEP §§ 806.05(c) and 808.02. Applicant submits that the Restriction Requirement mailed August 25, 2005 is improper because the Examiner has not established either of the requirements for supporting a Restriction Requirement.

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The Examiner Failed to Establish Two-Way Distinctness of the Inventions Because the Examiner did not Show that a Subcombination has Utility Either by Itself or in Other and Different Relations

Inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability, and (B) the subcombination can be shown to have utility either by itself or in other and different relations. See MPEP § 806.05(c). The burden is on the Examiner to suggest an example of separate utility for each subcombination, which utility must be other than used in the combination. See MPEP § 806.05(c), Examiner Note No. 3 and subsequent paragraph. In the restriction requirement mailed August 25, 2005, the Examiner did not include suggestions of separate utility for any of the claimed combination-subcombination groups. Therefore, Applicant submits that the Examiner failed to meet one of the requirements of Section 806.05(c) to show that the three inventions are distinct. Accordingly, Applicant submits that the Restriction Requirement is improper and should be withdrawn.

The Examiner Failed to Establish Reasons for Insisting on Restriction, i.e., Separate Classification, Status, or Field of Search

Groups I and II and Groups I and III:

The Examiner provided insufficient reasons for insisting that restriction between the inventions defined by Groups I and II and Groups I and III is necessary. MPEP § 808.02 states that the Examiner must show one of the following to establish reasons for insisting upon restriction: (1) separate classification thereof; (2) a separate status in the art when they are classifiable together; or (3) a different field of search. First, separate classification has not been met, as the Examiner has classified the Groups I and II and Groups I and III in the same class, namely Class 705, subclass 26. Secondly, the Examiner has failed to establish a separate status in the art when the inventions are classifiable together. MPEP § 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status. The Examiner has not cited any patents to give evidence of separate status; therefore, the Examiner has not established a separate status of the inventions. Additionally, the Examiner has not

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established that a separate field of search is required for the inventions defined by Groups I and II and Groups I and III. Applicant respectfully submits that a different field of search is not required for Groups I and II and Groups I and III. A different field of search is required where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists. See MPEP § 808.02. Specifically, Applicant respectfully submits that the same field of search will be required between Groups I and II and Groups I and III because claims from both groups relate to and identify commercial real estate service providers that provide commercial real estate services. Therefore, as stated in Section 808.02 of the MPEP, "Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions."

Accordingly, Applicant submits that the Examiner has failed to establish sufficient reasons for insisting on restriction between the inventions defined by Groups I and II and Groups I and III.

Groups II and III

The Examiner provided insufficient reasons for insisting that restriction between the inventions defined by Groups II and III is necessary. MPEP section 808.02 states that the Examiner must show one of the following to establish reasons for insisting upon restriction: (1) separate classification thereof; (2) a separate status in the art when they are classifiable together; or (3) a different field of search. First, separate classification has not been met, as the Examiner has classified Groups II and III in the same class, namely Class 705, subclass 26. Secondly, the Examiner has failed to establish a separate status in the art when the inventions are classifiable together. MPEP § 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status. The Examiner has not cited any patents to give evidence of separate status; therefore, the Examiner has not established a separate status of the inventions. Additionally, the Examiner has not established that a separate field of search is required for the inventions defined by Groups II and III. Applicant respectfully submits that a different field of search is not required for Groups II and III. A different field of search is

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required where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists. See MPEP § 808.02. Specifically, Applicant respectfully submits that the same field of search will be required between Groups II and III because claims from both groups relate to “request criteria defining [a] real estate service” and “request criteria identifying a specific property and [a] real estate service.” Specifically, in both Groups II and III the “request criteria” relate to “a request for information regarding a requested real estate service.” Therefore, as stated in Section 808.02 of the MPEP, “Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.”

Accordingly, Applicant submits that the Examiner has failed to establish sufficient reasons for insisting on restriction between the inventions defined by Groups II and III.

Applicant has addressed only the issues deemed most relevant at this point in rebutting the Restriction Requirement. Applicant’s decision not to address any requirement for a Restriction Requirement is not an admission that such requirement is met by the Examiner Restriction Requirement mailed August 25, 2005. Applicant reserves the right to address additional issues in future correspondence.

ELECTION

In order to be responsive to the requirement, the Applicant hereby elects, WITH TRAVERSE, Group I (Claims 1-4 and 11) for prosecution on the merits in this application. The Examiner is respectfully requested to reconsider his Restriction Requirement and act on all of the claims in the present application. If the Examiner does persist in his Restriction Requirement, Applicant reserves the right to file a petition and/or to file a divisional application directed to the Group II and Group III claims as proposed by the Applicant at a later date if they so desire.

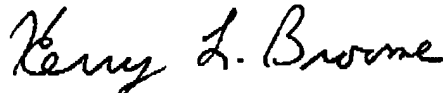
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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed August 25, 2005. Applicant has submitted remarks to traverse the Restriction Requirement. Examination of all the claims of record is hereby courteously solicited.

If the Examiner believes that any issues exist that can be resolved by telephone conference, or that any formalities exist that can be corrected by an Examiner's Amendment, please contact the undersigned at (404) 572-4647.

Respectfully submitted,



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